Remarks/Arguments

Claims 1, 11, and 20 have been amended for clarification and are fully supported by the specification. Claims 21-23 have been newly added. No other new matter has been added to the prosecution of this application. For at least the reasons stated below, Applicant believes that all claims are now in condition for allowance.

1. 35 U.S.C. § 112 Rejections

Claims 1-20 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention. Specifically, claims 1 and 11 have been rejected on the basis that the use of the word "user" in claim 1, lines 2 and 3, claim 1, lines 4 and 5, and claim 11, line 4 and 5, lack clear antecedent basis. Claims 1 and 11, as well as claim 20, have been amended to clarify the claims and to place them in allowance. In light of this amendment, Applicant respectfully requests that the rejection based upon 35 U.S.C. § 112, second paragraph, be withdrawn.

2. 35 U.S.C. § 103 Rejections

Claims 1 through 21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Weiss et al., U.S. Patent 6,354,490 (hereinafter *Weiss*), and further in view of Nishimura et al., Japan Patent JP404195256A (hereinafter *Nishimura*). While *Weiss* and *Nishimura* both disclose the creation of an account on a network, *Weiss* alone, or in combination with *Nishimura*, does not teach or suggest the claimed invention as reflected by presently amended claims 1, 11, and 20. Therefore, Applicant respectfully requests that Examiner's rejections be reconsidered and withdrawn.

A. Application of *Weiss*

Applicant's claimed invention is not an obvious extension of *Weiss*. "To establish a *prima facie* case of obviousness . . . the prior art reference (or references when combined) must teach or suggest *all* the claim limitations." MPEP § 2143 (second emphasis added). *Weiss* arguably discloses, as Examiner asserts, that "a customer may use one of a plurality of devices[,] including a personal computer[,] to open an account at a financial institution." Office Action at 3 (citing *Weiss* Abstract); *see also Weiss* col. 8, ll. 57-68 ("another . . . aspect of the present invention is provision of a system and method for opening a single account that includes a full range of financial components"). In contrast, Applicant's claimed invention details an invention markedly different from that of *Weiss*, specifically:

> 1. A method for creating a customer account utilizing a network, comprising the steps of:
>
> (a) receiving an account application from a customer, wherein the account application includes information relating to the customer and documentation relating to the customer;
>
> (b) utilizing a first computer to create a profile for the customer based on the account application received from the customer;
>
> (c) utilizing the first computer to create an account for the customer;
>
> (d) transmitting information relating to the created profile and account from the first computer to a second computer;
>
> (e) generating a notification utilizing the second computer, wherein the notification indicates that the account has been created; and
>
> (f) transmitting the notification from the second computer to the customer utilizing a network.

Weiss does not teach or suggest the creation of an account remotely, information of which is then transmitted to a second computer for confirmation as is claimed in Applicant's claimed invention. *Weiss* only discloses the method to create a new account *within a bank's established system* through a standardized user interface. *Weiss*, Fig. 1. Furthermore, *Weiss* does not suggest externalizing account creation because the basis of the entire

invention is internalizing all data storage in a centralized location to facilitate data sharing across bank products. *See Weiss, e.g.*, col. 4, ll. 13-15 ("The present invention provides an improved system for seamlessly accessing an integrated financial system."); Col. 5, ll. 16-20 ("An important aspect of the system of the present invention is that it permits data to flow up and down through the process so that once a salient piece of data is collected, the data is transmitted to every location where it is needed. In other words, all similar data fields are linked."). Without a suggestion from *Weiss* to externalize the account creation process, Applicant's claimed invention is not obvious because it discloses the creation of an account remote from the bank's centralized system. *See, e.g.*, Claim 1 ("(b) utilizing a first computer to create a profile for the customer based on the account application received from the customer; (c) utilizing the *first* computer *to create* an account for the customer; (d) transmitting information relating to the *created* profile and account from the first computer to a second computer") (emphasis added).

Applicant also disputes Examiner's notice of the banking industry's use of multiple computers to facilitate its business, such that the use of multiple computers suggests the Applicant's invention, thereby making it obvious. While Examiner is correct in the statement that "a bank [may] use more than one in computer in their establishment", such a statement, and notice of this fact, is irrelevant to rejecting Applicant's claimed invention. While a bank may use more than one computer, these computers are all connected via one *internal* network. Applicant's claimed invention does not utilize two computers within the same internal network, as they would exist within a bank, but instead incorporates external computers to a bank's internal network to complete the transaction. *See* Claim 1; Fig. 9 (use of internet). Because Applicant's claimed invention is nonobvious, rejection under 35 U.S.C. § 103(a) is inappropriate, and in light of the above arguments, Applicant respectfully requests the rejection be withdrawn.

B. Application of *Weiss* in view of *Nishimura*

Examiner also asserts that *Weiss* in view of *Nishimura* discloses the method of Applicant's claimed invention. However, a careful reading of *Nishimura* reveals that it, in conjunction with *Weiss*, does not teach or suggest Applicant's claimed invention. In fact, *Nishimura* is little different from *Weiss*, save for *Weiss*'s standardized user interface.

As stated in the constitution of *Nishimura*, "customer input[ed] account information at an ATM] is stored in a RAM 44. *A request* to open the account is issued by transmitting the telegram [in which information from the RAM 44 is included] *to a host CPU* 6 via an interface 46. . . *The CPU 6 generates a new file when no problem exists, and sends the telegram to inform the opening of the account.*" (emphasis added) As indicated by the italicized language, *Nishimura* contemplates the creation of an account also within the system (generated by the *host* CPU 6) instead of external to the system as in Applicant's claimed invention. *See* Claims 1, 11, and 20. Without other reference, the combination of *Weiss* and *Nishimura* does not teach or suggest Applicant's claimed invention of a separate computer creating the account, outside the host network, because both *Weiss* and *Nishimura* only concern themselves creating an account *within* the bank's host network. Therefore, rejection under 35 U.S.C. § 103(a) is inappropriate, and in light of the above argument, Applicant respectfully requests the rejection be withdrawn.

C. Dependent claims 2-10 and 12-19.

Applicant also submits that the rejections of dependent claims 2-10 and 12-19 should also be withdrawn as they depend on independent claims 1 and 11. Because independent claims 1 and 11 are in condition for allowance, rejection of such dependent claims is improper, and Applicant respectfully requests the rejections be withdrawn.

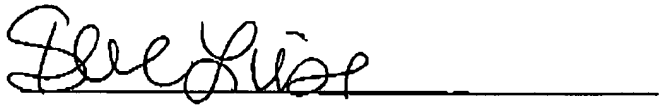
3. New Claims

Claims 21-23 have been newly added. These claims do not introduce any new matter because they are fully supported by the specification as filed. Applicants point out that the new claims are similar to the subject matter claimed in co-pending application 09/550,950 by the same inventor and assigned to the same entity. That co-pending application is under examination by the same Examiner as the present application. By introducing the limitations in claims 21-23, the co-pending application 09/550,950 may be allowed to go abandoned. As claims 21-23 depend on claims discussed above as allowable, Applicants respectfully request a notice of allowance for these new claims as well.

4. Conclusion

All rejections having been addressed, Applicant submits that all pending claims are in condition for allowance. Applicant respectfully requests reconsideration of the rejected claims and that a Notice of Allowance be issued in this case. In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at 612-607-7508. If any fees are due in connection with the filing of this paper, then the Commissioner is authorized to charge such fees including fees for any extension of time, to Deposit Account No. 50-1901 (Docket 60021-369201).

Respectfully submitted,



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